



33C

Sp. 338

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the reissue application of
Don A. Perry and H. Earl Wright
Title: Touch Enhancing Pad
Serial No. 07/337,253
Filed April 13, 1989

Art Unit 336
Examiner: R. Shay

#4
1-14-90

AMENDMENT

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

In an Office Action dated September 13, 1989, the Examiner rejected Claims 1 to 13 as being based upon an allegedly defective reissue declaration. The reissue declaration was allegedly defective in three respects: (1) It lacked certain required averments; (2) It omitted the date on which the discovery of the error occurred; and (3) It violated the recapture rule. Each of the alleged defects is discussed in turn.

The instant application was filed with two declarations: (1) a Declaration and Power of Attorney which contained averments regarding review of the specification, inventorship, duty of disclosure, etc.; and (2) a Reissue Declaration which described the error. The averments cited by the Examiner as missing from the Reissue Declaration were contained in the accompanying Declaration and Power of Attorney, but apparently the Examiner believes all the averments should be in a single document. Accordingly, the

two declarations have been combined into the enclosed Amended Reissue Declaration. This declaration is believed to satisfy all the requirements of 37 C.F.R. §§1.63 and 1.175.

It is alleged that the original Reissue Declaration failed to recite the date on which the discovery of the "error" occurred. The "error" was voluntarily amending the claims by an Amendment filed on August 29, 1986 to add the recitation that the enclosure is made of a single piece of material. This error was discovered when a polyurethane film was developed which outperformed latex rubber as an enclosure material and when the decision was made to switch from latex rubber to polyurethane film in the commercial product. As stated at page 2, line 13, of the Reissue Declaration, the polyurethane film was developed "by the fall of 1988" and, as stated at page 2, line 29, the decision to switch was made in "late 1988." The Amended Reissue Declaration specifies these dates more precisely.

Finally, the Reissue Declaration is allegedly to violate the recapture rule. As stated in Ball Corp. v. United States, 729 F. 2d 1429, 221 USPQ 289 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were canceled from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are narrower in scope than the canceled claims.

Ball Corp. involved an antenna assembly intended for use on missiles. The original claim recited that the assembly contained "at least one" conductive lead. During prosecution, the claims were amended to recite a "plurality" of leads, i.e., at least two leads. The reissue claim recited a

"single" lead. It was argued that the reissue claim violated the recapture rule. However, the court held that the recapture rule was not violated because the reissue claim was narrower in scope than the original claim: The original claim was for one or more leads and the reissue claim was for only one lead.

The situation in the instant application is almost identical, except the numbers are reversed. The original claim was directed to an enclosure of one or more pieces. The claim was amended to recite an enclosure of a single piece of material. The reissue claims recite an enclosure of two or more pieces. In summary, the reissue claims are narrower in scope than the cancelled claims. A claim directed to "two or more" pieces is narrower than a claim directed to "one or more" pieces because the embodiment containing only one piece has been excluded. Therefore, the recapture rule is not violated.

Also enclosed is a Supplemental Information Disclosure Statement.

In view of the Amended Reissue Declaration and in view of the above comments, the Applicants request that the rejection based on a defective reissue declaration be withdrawn.

Respectfully submitted,

Philip L. Bateman
Philip L. Bateman
Attorney for Applicants
Registration No. 30,127
Telephone No. (217) 429-4325